

Application No. 10/709,646
Technology Center 3711
Amendment dated August 17, 2006
Reply to Office Action of May 17, 2006

REMARKS

In the Office Action, the Examiner reviewed claims 1-20 of the above-identified US Patent Application, with the result that a previous objection of the drawings and previous rejections of the claims were withdrawn, claims 1-19 were rejected under 35 USC §102, and claim 20 (which depends from independent claim 16) was deemed to recite allowable subject matter. In response, Applicants have amended the claims as set forth above. More particularly:

Independent claim 16 has been amended to incorporate all limitations of its dependent claim 20 (now canceled without prejudice to Applicants), pursuant to the Examiner's conclusion that claim 20 (which depends from claim 16) recites allowable subject matter. As such, independent claim 16 and claims depending therefrom are believed to be allowable over the prior art of record.

Dependent claims 7 and 13 have been amended to further limit the weight range of the device, as set forth in paragraph [0015] of Applicants' specification.¹

¹ All references to pages and paragraphs in Applicant's electronically-filed application are those inserted by the USPTO authoring software.

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Applicants believe that the above amendments do not present new matter and strictly comply with 37 CFR §1.116(a) as being limited to reducing and simplifying the issues remaining in the examination of Applicants' application or in some other way requiring only a cursory review by the Examiner, namely, by placing claims 16-19 in condition for allowance and by amending dependent claims 7 and 13 to further limit the weight range of the device, a limitation that was not raised by the Examiner as being determinative to assessing the patentability of the claimed invention.² Consequently, Applicants believe that the above amendments do not raise new issues that would require further consideration and/or search by the Examiner, and place the claims in better condition for appeal.

Favorable reconsideration and allowance of remaining claims 1-19 are respectfully requested in view of the above amendments and the following remarks.

² MPEP §714.13 instructs:

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment . . . *requires only a cursory review by the examiner*, compliance with the requirement of a showing under 37 CFR 1.116(b) is expected in all amendments after final rejection. (Emphasis added.)

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§102 Rejection of Claims 1-15

Independent claims 1 and 8 and their respective dependent claims 2-7 and 9-15 were rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 3,969,080 to Conlon. Applicants respectfully request reconsideration of this rejection in view of the amendments presented above as well as the following comments.

As noted in §2131 of the MPEP:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ...claim. The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e. identity of terminology is not required. (Citations omitted).

Re Claims 1-7

Applicants' independent claim 1 requires a device (20) that is mountable on a golf club (10) and has an "outer perimeter having a recess defined therein that is sized and contoured to accommodate a portion of a hand gripping the second grip portion of the grip." Under the rejection, Conlon is not cited as having such a recess, and therefore the rejection is improper because

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the rejection does not explain how "each and every element as set forth in the claim is found, either expressly or inherently described," in Conlon.

Furthermore, Applicants cannot find any feature on Conlon's ring that could be termed a "recess" according to the ordinary meaning of the word "recess," e.g., Conlon's "opening" is not a "recess" that is "defined" in the "outer perimeter" of Conlon's ring. As such, Applicants believe that Conlon cannot be interpreted as describing a recess, either expressly or inherently, for the purpose of revising the basis for the current rejection under 35 USC §102.

Finally, Applicants believe that, for the purpose of making a new rejection under 35 USC §103, there is no motivation for Conlon's ring to be modified to include a recess as recited in claim 1 in view of the intended use of Conlon's ring as a weight.

In view of the above, Applicants believe that Conlon does not anticipate independent claim 1 or any of its dependent claims under the test for anticipation set forth at MPEP §2131.

Re Claims 8-15

As with claim 1, Applicants' independent claim 8 requires a device (20) with an "outer perimeter . . . having a recess defined therein that is sized

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and contoured to accommodate a portion of a hand gripping the second grip portion of the grip." Therefore, the arguments above regarding this limitation also apply to the rejection of claim 8 and its dependent claims.

Applicants' independent claim 8 further requires the device (20) to be actually "mounted on a golf club" with its "inner perimeter . . . contacting the grip of the club." Under the rejection, Conlon is not cited as disclosing a ring mounted on a golf club, and therefore the rejection is improper because the rejection does not explain how "each and every element as set forth in the claim is found, either expressly or inherently described," Conlon.

Furthermore, Applicants cannot find any statement in Conlon regarding Conlon's ring being mounted on a golf club. As such, Applicants believe that Conlon cannot be interpreted as describing, expressly or inherently, that Conlon's ring is used in combination with a golf club for the purpose of revising the basis for the current rejection under 35 USC §102.

Finally, Applicants believe that, for the purpose of making a new rejection under 35 USC §103, there is no motivation for Conlon's ring to be mounted on a golf club as recited in claim 8 in view of the intended use of Conlon's ring as a weight.

In view of the above, Applicants believe that Conlon also does not

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anticipate independent claim 8 or any of its dependent claims under the test for
anticipation set forth at MPEP §2131.

For all of the above reasons, Applicants respectfully request
withdrawal of the rejection under 35 USC §102 based on Conlon.

§102 Rejection of Claims 16-19

Independent claim 16 and its dependent claims 17-19 were rejected
under 35 USC §102 as being anticipated by U.S. Patent No. 5,152,831 to
Arcenas. As noted above, Applicants have amended independent claim 16 to
incorporate the allowable subject matter of its dependent claim 20. Therefore,
Applicants respectfully request withdrawal of this rejection

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Closing

In view of the above, Applicants believe the claims define patentable novelty over all the references, alone or in combination, of record. It is therefore respectfully requested that this patent application be given favorable reconsideration.

Should the Examiner have any questions with respect to any matter now of record, Applicants' representative may be reached at (219) 462-4999.

Respectfully submitted,

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